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EXAMINER

CORRIELUS, JEAN M

ART UNIT

PAPER NUMBER

2162

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/806,307

Applicant(s)

STOBBS ET AL.

Examiner

Jean M. Corrielus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This office action is in response to the preliminary amendment filed on March 22, 2004, in which claims 1-10 were canceled and claims 11-20 are presented for examination.

Information Disclosure Statement

2. The information disclosure statement (IDS) filed on October 06 and October 07, 2004 does not comply with the provisions of M.P.E.P. 609 because it cannot be understood. It has been placed in the application file. The information referred therein has been considered as to the merit.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 11-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 11 and 14 recites the claimed "generate a category metric corresponding to user-prescribed categories". The specification does not provide how the metric category has been created based on the user-prescribed categories. The specification does not even mention about creating a category metric. All that mentioned in the specification is that the metric breath information that is associated with

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each independent claim of the patent (see paragraph [0048]). It is unclear whether the applicant meant to say "metric breath information". Applicant is advised to clarify or at least show wherein such limitation is described in the specification.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 13 and 14 recite, "which it is closest". Pronouns are not permitted, only what is being referred by "it" should set forth in the claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chakrabarti et al., (hereinafter "Chakrabarti") US Patent no.6,389,436 and Barney et al., (hereinafter "Barney") US Patent no. 6,556,992.

As to claim 11, Chakrabarti discloses the claimed "providing user-prescribed categories, which were specified by a user;" (which the topic hierarchies 500 and 502 that manually pre classified by the users (col.15, lines 35-36); "retrieving a corpus of patent information from a database,

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wherein the patent information is information from multiple patent documents” (first corpus of the IBM patent server, which provides a corpus patent information (col.15, lines 37-42).

Applicant should duly note that during training, each sample document has a pre-assigned class, and hypertext classifier, which permit to explore any neighborhood of the sample and to know the assigned classes of document in the neighborhood. Chakrabarti does not explicitly disclose the claimed “analyzing said patent information to generate a category metric corresponding to user-prescribed categories and “associating said category metric with said patent information”

However, Chakrabarti discloses a category of probability vector of (0.2, 0.1, 0.15, 0.4) (col.6, lines 64-65); wherein said category probability vector is associated with the document information with the patent information (col.6, lines 66-67) and “storing said associated metric in a computer-readable dataset” wherein such associated metric is stored in the IBM patent server (col.15, lines 35-37). Barney, on the other hand, discloses the claimed “analyzing said patent information to generate a category metric corresponding to user-prescribed categories” by determining one or more patent metrics based on a first and a second quality to a statistically significant degree (col.7, lines 44-47); and “associating said category metric with said patent information” by linking a particular reported patents of interest and one or more ratings according to the determining of the patent metric (col.8, lines 7-14), “associated the patent metric with the patent information”, (col.7, lines 47-55); and storing said associated metric in a computer-readable dataset” wherein a computer accessible database is used and programmed to stored the associated metric for each patent in the first and second patent populations (col.8, lines 26-37 and lines 55-65). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Chakrabarti by the patent analysis system

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of Barney. Chakrabarti and Barney are both directed to the same field of endeavor. One having ordinary skill in the art would have found it motivated to use such modification for the purpose of statistically providing accurate probabilities of a desired value or quality being present or a future event occurring, given the analysis of the generated patent information.

As to claim 12, Chakrabarti discloses the claimed “wherein said patent information includes patent classification information and wherein said analyzing step is performed by defining a plurality of categories and mapping classification information onto said categories” (wherein the linkage between related topics among patents; patent on regulator system refers to transmission patent classification and patent on modulation cite on Oscillator patent classification (col.9, lines 55-59)).

As to claim 13, Chakrabarti and Barney disclose substantially the invention as claimed. In addition, Barney discloses the claimed “wherein said patent information includes claim text information to be analyzed” (col.8, lines 47-49; col.20, lines 48-66); “defining an eigenspace representing a training population of training claims each training claim having associated training text”(eigenspace is the statistic probability that represents the population training claims, wherein the criterion variables measure a selected quality of interest of a particular patent population (col.15, lines 5-11; col.17, lines 10-13) ; “representing at least a portion of said training claims in said eigenspace and associating a predefined category with each training claim in said eigenspace” assigning the probability value to each training claim (col.20, lines 60-65) ; and ”projecting the claim text information to be analyzed into said eigenspace and associating with said projected claim text the predefined category of the training claim to which it is closest

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within the eigenspace” providing matching of similarity by comparing the relatedness of one or more training claim in order to identify related or similar patents within a portfolio (col.20, line 66-col.21, line 8). It is important to note that, once training is completed, the accuracy of the system can be estimated by comparing the class output of the classifier with the known classifications of the testing documents (FIG. 4). If the accuracy is inadequate, a further training procedure, using a different collection of claims, or a reorganization of the taxonomy, may be carried out to retrain the system.

As to claim 14, Chakrabarti discloses the claimed “providing user-prescribed categories, which were specified by a user;” (which the topic hierarchies 500 and 502 that manually pre classified by the users (col.15, lines 35-36); “retrieving a corpus of patent information from a database, wherein the patent information is information from multiple patent documents” (first corpus of the IBM patent server, which provides a corpus patent information (col.15, lines 37-42).

Applicant should duly note that during training, each sample document has a pre-assigned class, and hypertext classifier, which permit to explore any neighborhood of the sample and to know the assigned classes of document in the neighborhood. Chakrabarti does not explicitly disclose the claimed “analyzing said patent information to generate a category metric corresponding to user-prescribed categories and “associating said category metric with said patent information”; defining an eigenspace representing a training population of training claims each training claim having associated training text”; “representing at least a portion of said training claims in said eigenspace and associating a predefined category with each training claim in said eigenspace”; and “projecting the claim text information to be analyzed into said eigenspace and

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associating with said projected claim text the predefined category of the training claim to which it is closest within the eigenspace. However, Chakrabarti discloses a category of probability vector of (0.2, 0.1, 0.15, 0.4) (col.6, lines 64-65); wherein said category probability vector is associated with the document information with the patent information (col.6, lines 66-67) and “storing said associated metric in a computer-readable dataset” wherein such associated metric is stored in the IBM patent server (col.15, lines 35-37). Barney, on the other hand, discloses the claimed “analyzing said patent information to generate a category metric corresponding to user-prescribed categories” by determining one or more patent metrics based on a first and a second quality to a statistically significant degree (col.7, lines 44-47); and “associating said category metric with said patent information” by linking a particular reported patents of interest and one or more ratings according to the determining of the patent metric (col.8, lines 7-14), “associated the patent metric with the patent information”, (col.7, lines 47-55); storing said associated metric in a computer-readable dataset” wherein a computer accessible database is used and programmed to stored the associated metric for each patent in the first and second patent populations (col.8, lines 26-37 and lines 55-65); “wherein said patent information includes claim text information to be analyzed” (col.8, lines 47-49; col.20, lines 48-66); “defining an eigenspace representing a training population of training claims each training claim having associated training text”(eigenspace is the statistic probability that represents the population training claims, wherein the criterion variables measure a selected quality of interest of a particular patent population (col.15, lines 5-11; col.17, lines 10-13); “representing at least a portion of said training claims in said eigenspace and associating a predefined category with each training claim in said eigenspace” assigning the probability value to each training claim (col.20,

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lines 60-65) ; and "projecting the claim text information to be analyzed into said eigenspace and associating with said projected claim text the predefined category of the training claim to which it is closest within the eigenspace" providing matching of similarity by comparing the relatedness of one or more training claim in order to identify related or similar patents within a portfolio (col.20, line 66-col.21, line 8). It is important to note that, once training is completed, the accuracy of the system can be estimated by comparing the class output of the classifier with the known classifications of the testing documents (FIG. 4). If the accuracy is inadequate, a further training procedure, using a different collection of claims, or a reorganization of the taxonomy, and may be carried out to retrain the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Chakrabarti by the patent analysis system of Barney. Chakrabarti and Barney are both directed to the same field of endeavor. One having ordinary skill in the art would have found it motivated to use such modification for the purpose of statistically providing accurate probabilities of a desired value or quality being present or a future event occurring, given the analysis of the generated patent information.

As to claim 15, Barney discloses the claimed "wherein said patent information includes patent classification information and wherein said analyzing defining a plurality of categories and mapping classification information onto said categories" (col.14, lines 25-35).

As to claim 16, Barney discloses the claimed "wherein said patent information includes using both patent classification information and linguistic analysis results to determine said

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category metrics to be associated with the patent documents” (col.19, lines 56-64; col.19, lines 26-32).

As to claim 17, Barney discloses the claimed “wherein the category metrics are indicative of technical areas of the patent documents” col.19, lines 14-18).

As to claim 18, Barney discloses the claimed “ retrieving text of claims from the database, wherein the text of claims are from the plurality of patent documents”; “analyzing the text of the claims in order to generate claim breadth metrics for the claims, wherein a claim breadth metric is indicative of claim breadth of a claim, wherein the claim breadth metrics are used to analyze the claims” (col.20, lines 38-41).

As to claim 19, Barney discloses the claimed “ wherein values of the category metrics are predetermined” (col.18, lines 60-63).

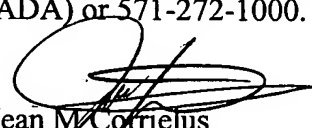
As to claim 20, Barney discloses the claimed “wherein values of the category metrics are dynamically determined” (col.18, lines 60-63).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean M. Corrielus whose telephone number is (571) 272-4032. The examiner can normally be reached on 10 hours shift.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jean M. Corrielus
Primary Examiner
Art Unit 2162

November 10, 2006